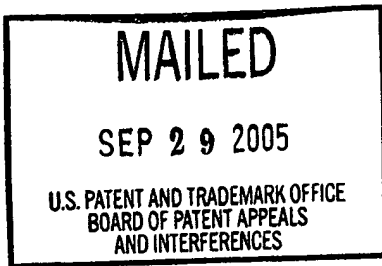


The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte MICHAEL D. PETERSON and
TERRY J. WICKLAND



Appeal No. 2005-1366
Application No. 09/658,374

ON BRIEF

Before WALTZ, TIMM, and PAWLIKOWSKI, Administrative Patent Judges.
WALTZ, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on an appeal from the primary examiner's rejection of claims 1 through 13 and 15 through 20, which are all of the claims pending in this application. Although the action appealed from was a non-final rejection (Brief, page 1),¹ we have jurisdiction since the claims have been twice rejected. See 35 U.S.C. § 134 (2003) and *Ex parte Lemoine*, 46 USPQ2d 1420, 1422-23 (Bd. Pat. App. & Int. 1998).

¹We refer to and cite from appellants' Brief dated May 3, 2004.

According to appellants, the invention is directed to an enclosure vent to vent hydrogen gas while controlling the release of volatile, organic compounds from an enclosure containing transuranic (radioactive) waste to an environment surrounding the enclosure (Brief, page 3). Representative independent claim 1 is reproduced below:

1 . An enclosure vent adapted to vent hydrogen gas while controlling release of volatile organic compounds from an enclosure containing transuranic waste to an environment surrounding the enclosure while being resistant to corrosion from corrosive materials including chlorinated solvents, hydrochloric acid and nitric acid, the enclosure vent comprising:

a housing defining a chamber therein having a first opening adapted to communicate with said enclosure and a second opening adapted to communicate with the surrounding environment, the housing being made of a nickel, chromium, molybdenum alloy having a resistance to corrosion from said corrosive elements for at least 200 years;

a filter media disposed in said chamber between the first and second openings for venting hydrogen gas from the container, the filter media being a carbon-to-carbon filter media for providing a hydrogen permeability greater than $10E-06$ mol/S/mol fraction weight, a removal of 0.45 micron particles exceeding 99.00% at an air flow capacity less than 200 ml/min., at a pressure differential less than 1.0 inch, and

a seal between the filter media and the housing, the seal consisting of direct engagement between the nickel, chromium, molybdenum alloy of the housing and the carbon-to-carbon filter media.

The examiner has relied upon the following references as evidence of obviousness:

| | | |
|---------------------------------|-----------|---------------|
| Brassell et al. (Brassell '328) | 4,500,328 | Feb. 19, 1985 |
| Kalota et al. (Kalota) | 4,996,369 | Feb. 26, 1991 |

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| | | |
|----------------------------------|-----------|---------------|
| Seibert et al. (Seibert) | 5,353,949 | Oct. 11, 1994 |
| Carpinella | 5,686,700 | Nov. 11, 1997 |
| Wickland et al. (Wickland) | 5,727,707 | Mar. 17, 1998 |
| McKedy | 5,839,593 | Nov. 24, 1998 |
| Brassell et al. (Brassell '669) | 6,041,669 | Mar. 28, 2000 |
| Finkelstein et al. (Finkelstein) | 6,139,931 | Oct. 31, 2000 |

The following rejections are before this merits panel for review in this appeal:²

(1) claims 1-13 and 15-20 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement (Answer, page 3, referring to the Office action dated June 17, 2003);

(2) claims 1, 2, 7 and 18-20 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Brassell '328 in view of Kalota, and Finkelstein or McKedy (*id.*);

²The rejections of (1) claim 1 for obviousness-type double patenting over U.S. Patent 6,413,304 in view of Kalota, Finkelstein or McKedy; (2) claim 1 for obviousness-type double patenting over U.S. Patent 6,395,050 in view of Kalota, Finkelstein or McKedy; and (3) claim 1 under 35 U.S.C. § 103(a) over the corresponding references listed in (1) and (2) above have been withdrawn by the examiner (Brief, pages 1 and 2; Answer, page 2, ¶(6)).

(3) claims 3-7 and 15 stand rejected under § 103(a) over the prior art as applied in rejection (2) further in view of Wickland (*id.*);

(4) claims 8, 10, 16 and 17 stand rejected under § 103(a) over the prior art as applied in rejection (3) further in view of Carpinella (*id.*);

(5) claims 9 and 11 stand rejected under § 103(a) over the prior art as applied in rejection (4) further in view of Seibert (*id.*);³

(6) claims 1, 2, 12, 13 and 18-20 stand rejected under § 103(a) over Brassell '669 in view of Brassell '328, Kalota and Finkelstein or McKedy (*id.*);

(7) claims 3-7 and 15 stand rejected under § 103(a) over the prior art as applied in rejection (6) further in view of Wickland (*id.*);

(8) claims 8, 10, 16 and 17 stand rejected under § 103(a) over the prior art as applied in rejection (7) further in view of Carpinella (*id.*); and

³The examiner erroneously lists claims 9 and 10 as included in this rejection (Answer, page 3) but correctly lists claims 9 and 11 in the corresponding rejection in the Office action dated June 17, 2003 (page 6). This error is harmless in view of appellants' correct listing of the claims in this rejection (Brief, page 2) and our disposition of this appeal *infra*.

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(9) claims 9 and 11 stand rejected under § 103(a) over the prior art as applied in rejection (8) further in view of Seibert (Answer, page 4, referring to the Office action dated June 17, 2003).

Based on the totality of the record, including appellants' arguments in the Brief and Reply Brief, as well as the opposing views of the examiner in the Answer, we reverse all of the rejections on appeal essentially for the reasons stated in the Brief, Reply Brief, and those reasons set forth below.

OPINION

A. The Rejection under § 112, ¶1

The only finding made by the examiner in both the Office action dated June 17, 2003, and the Answer is that "[t]here is no support in the disclosure as originally filed for the filter media being sealed by 'direct contact' with the housing" (Office action dated June 17, 2003, page 2, noting this phrase was introduced by amendment dated Sep. 26, 2002).

Appellants point to Figures 3 and 8, as well as the original specification at the abstract, page 4, ll. 19-24, page 6, ll. 18-19, and the Comparative Examples as support for the term "direct contact" [sic, direct engagement; see claim 1 on appeal]. See the Brief, pages 6-7, and the Reply Brief, pages 1-3.

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It is well established that the claimed subject matter need not be described *ipsis verbis* in order to satisfy the disclosure requirement of section 112. See *In re Lukach*, 442 F.2d 967, 969, 169 USPQ 795, 796 (CCPA 1971). The disclosure need only reasonably convey to persons skilled in the art that the inventor had possession of the subject matter in question. See *In re Edwards*, 568 F.2d 1349, 1351-52, 196 USPQ 465, 467 (CCPA 1978). In rejecting a claim under the first paragraph of section 112, it is incumbent upon the examiner to establish that the originally filed disclosure would not have reasonably conveyed to one having ordinary skill in the art that appellants had possession of the now claimed subject matter. See *Wang Laboratories, Inc. V. Toshiba Corp.*, 993 F.2d 858, 865, 26 USPQ2d 1767, 1774 (Fed. Cir. 1993); see also *In re Alton*, 76 F.3d 1168, 1175, 37 USPQ2d 1578, 1583 (Fed. Cir. 1996). It is also well settled that the original drawings of an application may provide a "written description" of an invention as required by section 112. See *Vas-Cath Inc. V. Mahurkar*, 935 F.2d 1555, 1564, 19 USPQ2d 1111, 1118 (Fed. Cir. 1991).

In view of our case law precedent discussed above, we determine that the examiner's mere statement that the words "direct contact" [sic, "direct engagement"] do not appear in the

original disclosure is not sufficient to meet the examiner's burden of prima facie establishing a failure to comply with the written description requirement. Furthermore, the examiner has not replied to appellants' countervailing arguments that the specification reasonably conveys to an artisan that appellants were in possession of the concept now claimed (Brief, pages 6-7, citing the specification at page 4, ll. 19-24, and page 6, ll. 18-19; Reply Brief, pages 1-3; and the Answer, page 4).⁴ The examiner fails to address the issue of whether a "knife edge seal," clearly disclosed in the original specification at page 4, provides support for the broader terminology "direct engagement" now in question (see the Brief, page 13). Additionally, the examiner inexplicably includes claim 19 in this rejection although this claim is limited to the knife edge seal disclosed in the original specification (Brief, pages 12-13).

⁴We note the examiner's remarks concerning appellants' Figures 3 and 8 (Answer, page 4). However, we also note that assignee's prior patents do show the RTV sealant layer in their drawings (see Wickland et al., U.S. Patents 6,395,050 and 6,413,304, Figure 2, number "42" in the '050 patent and Figure 5, number "62" in the '304 patent, as well as number "25" in Figure 1 labeled as "Prior Art").

For the foregoing reasons, we cannot sustain the examiner's rejection of all appealed claims for failure to comply with the written description requirement of section 112, first paragraph.

B. The Rejections based on § 103(a)

For rejections (2) through (5) above, the examiner relies on Brassell '328 as the primary reference, finding that Brassell '328 "teaches an enclosure vent comprising a housing **1** [sic, the housing or container is numbered as **2** while the filter is numbered as **1**] having first and second openings and a unitary filter element," including a radially extending flange and an annular shoulder, where the filter media is sealed with the housing by direct engagement with the alloy comprising the housing since the filter contacts at least a portion of the housing (final Office action dated June 17, 2003, page 4). The examiner immediately thereafter finds that Brassell '328 is "silent regarding the material of the housing or a *direct seal* between the filter media and the housing." *Id.* at page 5, italics added.

The examiner applies both Finkelstein and McKedy for the teaching that it was "known to provide a media to a housing with direct contact" (*id.*). Therefore the examiner concludes that it

would have been obvious to one of ordinary skill in the art at the time of appellants' invention to use direct sealing engagement between the filter media and the housing of Brassell '328 as taught by either Finkelstein or McKedy because "[d]oing so eliminates the need for additional manufacturing steps and reduces the manufacturing costs of enclosure vent housing." *Id.*

Contrary to the examiner's position (Answer, page 4), we determine that Brassell '328 discloses sealing the filter into the container but only teaches the use of a RTV high temperature sealant (col. 8, ll. 24-30). Brassell '328 further discloses examples using RTV high temperature silicone sealant, and teaches that improvements in performance have been attributed to compression of the silicone sealant (col. 10, ll. 10-15 and 41-44; see also col. 11, ll. 15-18). Accordingly, we determine that the examiner has failed to establish that there is any disclosure or suggestion in Brassell '328 that no sealant be used or that a direct engagement seal be used (Reply Brief, page 3).

Furthermore, as admitted by the examiner, Finkelstein and McKedy are not directed to filter media (Answer, page 5). As correctly argued by appellants (Brief, pages 9-10), Finkelstein is directed to a gas barrier layer to reduce gas transmission in a carbonated beverage container, where a liner **102** includes an adhesive or tie

layer **112** and **114** (col. 3, ll. 5-27, and col. 4, ll. 24-26). Similarly, McKedy is directed to a method for removing oxygen from a container by dispersing an oxygen absorbent in a liner, attaching the liner directly to an inner surface of a container cap, and placing the cap over an opening in the container such that the liner seals the opening and absorbs oxygen within the container (col. 2, ll. 34-40).

The examiner has not met the initial burden of convincingly explaining why the secondary references to Finkelstein and McKedy can be combined with the primary reference to Brassell '328. The examiner must establish a specific reason, suggestion or motivation for combining the references as proposed, not a general unsupported reason such as "reduces the manufacturing costs" (Answer, page 5). See *In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). The examiner has also failed to establish why one of ordinary skill in the art would have applied the teachings from beverage container liners (Finkelstein and McKedy) to the filter media of Brassell '328.

The remaining secondary and tertiary references (Kalota, Wickland, Carpinella, and Seibert) are not applied to show "direct engagement" of the filter seal and thus do not remedy the

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deficiencies noted above (final Office action dated June 17, 2003, pages 5-6).

Rejections (6) through (9) above are based on Brassell '669 and the references as discussed above (final Office action, pages 6-9). However, we are in agreement with appellants that Brassell '669 does not add anything to the remainder of the references, as the examiner admits that this reference fails to disclose the claimed structure (Brief, page 11; final Office action, page 7).

For the foregoing reasons, as well as those stated in the Brief and Reply Brief, we determine that the examiner has not established a prima facie case of obviousness in view of the reference evidence. Therefore, we reverse all rejections on appeal based on section 103(a).

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C. Summary

The rejection of claims 1-13 and 15-20 under 35 U.S.C. § 112, ¶1, is reversed. All of the prior art rejections on appeal based on 35 U.S.C. § 103(a) have also been reversed.

The decision of the examiner is reversed.

REVERSED

THOMAS A. WALTZ
Administrative Patent Judge


CATHERINE TIMM
Administrative Patent Judge

BOARD OF PATENT
APPEALS
AND
INTERFERENCES

BEVERLY A. PAWLIKOWSKI
Administrative Patent Judge

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